

REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

Applicant would also like to thank the Examiner and the Supervisory Patent Examiner for taking the time to discuss the present Office action in an interview conducted on April 17, 2008 at 1:30pm. A Statement of Substance of Interview is filed with the present amendment, making a record of a summary of the interview. As is discussed in detail below, Applicant contends that the cited art fails to teach the apparatus as recited in claims 1, 2, and 5.

Initially, the Applicant disagrees with the following statements made by the Examiner:

- (1) "In applicant's reply, applicants state on the record, that the Examiner has met the merits of the elected claims."
- (2) "Applicants have also pointed out in their reply, that Goto et al teaches, suggest, and gives motivation for the method as described in amended claims 1. A method therefore of using/operating the apparatus of Claims 1 & 2 would have been obvious to one of ordinary skill in the art at the time the invention."

Contrary to the Examiner's statements, the Applicants only stated on the record that Goto fails to teach the features of the presented claims. The Applicants do not concede that the Examiner "has met the merits of the elected claims". Moreover, the Applicants certainly do not "point out" that Goto renders the method of claim 1 obvious. Initially, claim 1 is an apparatus claim and has only been discussed as such. Further, to the extent that claim 1 includes functional recitations, the only

functional discussion provided distinguishes claim 1 from Goto. Thus, the Examiner's statements are considered baseless.

Claims 1, 2, and 5 stand rejected as being anticipated by Goto et al. (JP 3142606). The rejections are traversed for the following reasons.

The Applicant respectfully requests that the Examiner reconsider the arguments in favor of patentability presented in Amendment "A". The arguments will not be repeated, but are hereby incorporated in full. Based on the Examiner's comments in the "Response to Arguments" section of the present Office action, the Applicant believes that the Examiner's rejection is based on a misunderstanding of the Applicant's prior argument. Further, the Applicant asserts that claim 1 does recite structure that differentiates claim 1 from the teachings of Goto.

Initially, with reference to the argument presented in Amendment "A", the differences between Goto and claim 1 extend beyond the fact that Goto fails to teach a rinsing section wherein a rinsing liquid in a bath is exchanged during rinsing.

While this assertion is considered correct, Goto's failure to teach this feature of claim 1 stems from the fact that Goto does not teach a second rinsing section as defined in claim 1. Rather, Goto teaches a second tub used exclusively for receiving dirty washing liquid expelled from the needle. The second rinsing section of claim 1 is defined as having a rinsing solution therein, and having the needle soak in the rinsing solution. The second tub of Goto is not equivalent to the second rinsing section of claim 1. The difference in the use of the second rinsing section of claim 1 and the tub for receiving the discharged washing liquid of Goto provide a relevant framework for understanding their respective structural differences.

In supporting the rejection, the Examiner cites to claim 2 of Goto as providing

a specific recitation of the second rinsing section. Claim 2, in its entirety, reads:

"A method for washing the channel of an auto-sampler according to Claim 1 wherein a plurality of different washing liquids are prepared, and along with sequential insertion of the needle within this plurality of washing liquids the washing liquid is absorbed in and emitted out."

The Examiner apparently reads this claim as teaching a second rinsing section with a second rinsing bath in which the needle is soaked. However, claim 2 of Goto only teaches that there are a plurality of different washing liquids. The plurality of washing liquids are not disposed in different rinsing baths, but are selectively disposed in the first tub. Thus, this portion of Goto does not teach a second rinsing section with a second rinsing bath in which the needle is soaked.

As mentioned above, the Goto needle is not soaked in the second tub. Rather, the second tub is an empty basin into which the needle discharges the rinsing liquid absorbed in the first tub. The liquid discharged from the needle is then removed from the second tub. More specifically, Goto teaches a first tub containing a washing liquid and an empty second tub. The needle absorbs the washing liquid from the first tub, moves to the second tub, expels the washing liquid into the second tub, and is finished with the washing method. The discharged liquid is expelled from the second tub.

Claim 1 requires a "second rinsing section", wherein said second rinsing section is "for rinsing said needle by soaking said needle in a second rinsing liquid". Claim 1 continues to recite that the second rinsing liquid is "in a second rinsing bath". The "second rinsing liquid in said second rinsing bath is exchanged during the rinsing operation". The structural definition provided by the above recitation will be described in further detail below.

Goto does not teach that the second rinsing section includes a "second

rinsing bath" having a second rinsing liquid disposed therein, wherein the needle is rinsed in the second rinsing bath "by soaking said needle in a second rinsing liquid".

Additionally, Goto fails to teach a second rinsing liquid in a second rinsing bath wherein the second rinsing liquid is "exchanged during the rinsing operation".

The Examiner appears to believe that such differences are not relevant because they arise as a result of method recitations in an apparatus claim. As the patentability of an apparatus claim depends on the structural features of the apparatus and not the method of using the apparatus, the Examiner apparently concludes that such differences are not relevant in considering the patentability of claim 1. If so, the Examiner's conclusion is in error.

The use of functional language in an apparatus claim cannot be altogether dismissed without further consideration. "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used."

MPEP 2173.05(g). Thus, any language the Examiner perceives as being "functional" or "method language" in claim 1 must still be evaluated for the structure such language fairly conveys to a person of ordinary skill in the art. With this in mind, the recitations of paragraph c) of claim 1 will be discussed in detail.

The first portion of paragraph c) reads: "a second rinsing section for rinsing said needle by soaking said needle in a second rinsing liquid in a second rinsing bath". This portion affirmatively recites a second rinsing section having a second rinsing bath and a second rinsing liquid. These three structural elements are considered to be indisputably recited.

The language surrounding these three elements provides a structural

definition of the elements. The second rinsing liquid is recited as being in a second rinsing bath, both of which are associated with the second rinsing section. With reference to paragraph b) of claim 1, a first rinsing liquid in a first rinsing bath is recited as being associated with the first rinsing section. Read together, paragraphs b) and c) of claim 1 require a first rinsing liquid associated with the first rinsing section and a second rinsing liquid associated with the second rinsing section. While Goto teaches a plurality of different washing liquids, Goto does not teach that one washing liquid will be used in the first tub and one washing liquid will be used in the second tub. The plurality of washing liquids of Goto are all associated with the first tub (where the needle absorbs the liquid). The second tub is where the needle expels the liquid. Goto does not teach a first washing liquid associated with the first tub and a second washing liquid associated with the second tub, as required by the presently claimed invention.

Further, the second rinsing section of claim 1 requires that the needle be soaked in a second bath. This recitation conveys to one skilled in the art that: the second bath is capable of being filled with a second rinsing liquid, the second bath is, in fact, filled with liquid suitable for rinsing the needle by soaking, and that the needle is capable of sufficiently entering the second bath so as to soak therein.

The second tub of Goto receives the liquid expelled from the needle. The Goto second tub is not filled with a washing liquid different from that of the first tub. Rather, the washing liquid of the first tub is conveyed to and deposited in the second tub by the needle. At the time of expulsion, the washing liquid is dirty, having washed the interior of the needle. Thus, Goto does not teach a second bath or tub filled with a liquid suitable for rinsing the needle.

Further, paragraph b) of claim 1 also recites that "the second rinsing liquid in said second rinsing bath is exchanged during the rinsing operation". This recitation imparts structural features to the second rinsing section enabling the second rinsing section to perform said exchange. Further, it is noted that the term "exchanged" in the claim refers to an actual exchange of liquid, whereby the second rinsing liquid is both introduced into and removed from the second rinsing bath.

With reference to the second tub of Goto, liquid is introduced from the needle and can be expelled from the tub. However, it is initially noted that the liquid introduced into the tub is not a "second rinsing liquid", but is a dirty first washing liquid. This is likewise true for the liquid expelled from the tub. Finally, Goto teaches that the liquid is expelled from the needle into the tub and, following the expulsion of the liquid, the tub discharges the dirty liquid. There is no simultaneous exchange of a second rinsing liquid, as the term is commonly understood.

For these reasons, claim 1 is considered to be allowable over the Goto reference. Reconsideration and withdrawal of the rejection is requested. Claims 2 and 5 depend from claim 1 and are likewise considered allowable over the art.

With further reference to claim 5, the invention defined therein further includes a pump fluidly connected to the second bath. The pump is adapted to supply the second rinsing liquid to the second bath so as to exchange the second rinsing liquid in the second liquid bath. It is pointed out to the Examiner that the pump of Goto (item 25 in Figure 1 of Goto) is not connected to the second tub (where the washing liquid is discharged), as required by claim 5.

For this reason, claim 5 is considered to be independently allowable over the art. Therefore, notwithstanding the patentability of claim 1, the rejection of claim 5

should be withdrawn.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. NGB-15306.

Respectfully submitted,

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